

Remarks

Applicants respectfully request reconsideration and allowance of the captioned application.

The Final Office Action allowed independent claim 16 and its dependent claims 17-21. It stated that dependent claims 5, 6, 13 and 14 would be allowable if written in independent form. It rejected independent claims 1 and 9 and their dependent claims 2-4, 8 and 10-12 as anticipated by Slavsky, but stated “[i]f the applicant changes the language to ‘the latch and latch fastener are structured, dimensioned and positioned in direct engagement with the spine’, in claims 1 and 9, the claims will be allowed.” Independent claims 1 and 9 are amended for clarification, using language that is substantially consistent with the proposed language. The differences with the proposed language are discussed immediately below.

The undersigned thanks the Primary Examiner for her courtesy in the telephone conversation on 16 January 2007. We discussed the proposed language, including that (1) “latch” and “latch fastener” are referred to as “latch portion” and “latch portion fastener” in claims 1 and 9; and (2) the latch portion includes the latch portion fastener in those claims so it would be redundant and confusing to include “the latch portion and” in the proposed language. We also discussed why “for direct engagement with the spine” should be allowable in claim 9, in which the spine is not part of the claimed sign mount (in contrast with claim 1 in which the spine is part of the claimed sign mounting system).

In particular, it is permissible to use a functional limitation to define something by what it must be able to do in relation to an unclaimed element. “There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does

not, in and of itself, render a claim improper.” MPEP §2173.05(g). That section of the MPEP concluded, “[i]n a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as ‘members adapted to be positioned’ ...serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.” The MPEP cited *In re Venezia*, 189 USPQ 149 (CCPA 1976). In fact, the court held that such limitations also served to define attributes of claimed components interrelated with unclaimed components of an unclaimed assembly.

The representative claim in *Venezia* was for “a splice connector kit having component parts capable of being assembled in the field at the terminus of high voltage shielded electrical cables... each having a conductor surrounded by an insulating jacket...” The cables, their conductors, and their insulating jackets were not part of the claimed kit. The claimed kit comprised “a pair of sleeves... each... adapted to be fitted over the insulating jacket,” and “electrical contact means adapted to be affixed to the terminus of each exposed conductor,” and “a housing... whereby said housing may be slideably positioned over one of said cables....” *Id.* at 150. The court said,

We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly....

We also fail to see any basis for rejecting appellant’s claims for being incomplete in failing to recite a completed assembly. Appellant’s invention is a “kit” of parts which may or may not be made into a completed assembly.

Id. at 152. Similarly, in the captioned application, claims may include a “latch portion fastener structured, dimensioned and positioned for direct engagement with the spine” even if

the spine is not claimed. In that case, being “structured, dimensioned and positioned for direct engagement with the spine” is a required attribute of the claimed latch portion fastener.


The Office Action characterized the Slavsky screw 6 and the Slavsky lower edge 8 of price tag molding 7 as together being the claimed latch portion (and also as being the claimed latch portion fastener threaded stub). However, they do not possess the required attribute and cannot satisfy the claim language. The Office Action characterized the Slavsky bracket 10 as the claimed spine. Neither the Slavsky screw 6 nor the lower edge 8 of the Slavsky molding 7 even touches the Slavsky bracket 10. Neither is structured, dimensioned and positioned for direct engagement with bracket 10. Screw 6 is positioned to screw into Slavsky shelf 4 (that the Office Action treated as the vertical upright post). It is on the opposite end of the Slavsky shelf clamp from bracket 10, and it cannot engage bracket 10. Slavsky price tag molding 7 and its lower edge 8 are on the inside of the Slavsky shelf clamp, and cannot engage bracket 10 that is on the outside of the shelf clamp.

Independent claims 1 and 9 are amended for clarification, using language that is substantially consistent with the language proposed in the Office Action. Applicants submit that the application is in condition for allowance, and request reconsideration and allowance. If a telephone conference would expedite prosecution of the application, the applicants request the Primary Examiner to call the undersigned at the below-listed telephone number.

Respectfully submitted,

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WELSH & KATZ, LTD.
120 South Riverside Plaza
22nd Floor
Chicago, Illinois 60606
(312) 655-1500



L. Friedman
Reg. No. 37,135